

REMARKS

35 U.S.C. §101 rejections

In the August 19, 2009 Office Action claims 23 - 28 are rejected under 35 U.S.C. §101 as representing non statutory subject matter. The Assignee traverses the rejections for non statutory subject matter in a number of ways. First, by noting that the Office Action has failed to establish a prima facie case of non statutory subject matter. Second, by noting that the claim rejections are not in compliance with the Administrative Procedures Act and are therefore moot. Third, by noting that the claims describe inventions that transform data representative of an organization that physically exists into a different state or thing and thus represent statutory subject matter.

In particular, the August 19, 2009 Office Action fails to establish a prima facie case of non statutory subject matter for claim 23 - 28 in a number of ways. It is well established that the burden is on the USPTO to set forth a prima facie case of unpatentability In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In spite of this well known requirement, the August 19, 2009 Office Action contained only conclusory statements that the rejected claims represented non-statutory subject matter. In short, the complete absence of evidence leads to the inevitable conclusion that the Examiner has failed to establish a prima facie case that would support a §101 rejection for a single claim.

35 U.S.C. §103 rejections

In the August 19, 2009 Office Action claims 1 - 19 and 23 - 28 are rejected under §103(a) as being obvious given Published Patent Application 2003/0208427 (hereinafter Peters) in view of Published Patent Application 2001/0039525 (hereinafter Messmer). The Examiner has cited the Peters and Messmer documents as a reference. The Assignee respectfully traverses the rejections for obviousness in three ways. First, by noting that the cited combination of documents fails to establish a prima facie case of obviousness. Second, by noting that the assertions regarding the alleged obviousness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. Third, by noting that the claim rejections are non-statutory.

As discussed previously, the August 19, 2009 Office Action fails to establish the prima facie case of obviousness required to sustain the rejections of claims 1 - 19 and 23 - 28 by citing a combination of documents that teach away from the claimed invention, citing a combination of documents that fails to teach one or more limitation for every claim, failing to explain the

combination as required by KSR v Teleflex, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function. Rather than providing evidence of obviousness, the cited documents provide substantial evidence of the novelty, non-obviousness and newness of the claimed invention. The Assignee notes that there are other ways in which the 103 claim rejections can be traversed.

Request for Correction

In accordance with the relevant statutes and precedents the Assignee is entitled to expect and receive: an unbiased patent application examination conducted by an Examiner with knowledge of the relevant arts who follows the law. To date, the activity associated with the instant patent application bears no resemblance to the patent application examination standards dictated by statute and precedent. Prompt correction is requested. The Examiner also failed to list claims 20 – 23 which were withdrawn because of a restriction requirement.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,
Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President
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